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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/113,071 07/10/98 SILVERBROOK

K ART32US

MM91/0727

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AIR MAIL

EXAMINER

KIM, P

ART UNIT

PAPER NUMBER

2851

DATE MAILED:

07/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No.  
09/113,071

Applicant(s)

Silverbrook et al.

Examiner

PETER KIM

Art Unit

2851



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Jun 11, 2001

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

4)  Claim(s) 1 and 3-17 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1 and 3-17 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

15)  Notice of References Cited (PTO-892) 18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 19)  Notice of Informal Patent Application (PTO-152)

17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20)  Other: \_\_\_\_\_

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## **DETAILED ACTION**

1. Applicant's arguments filed on 6/11/01 (paper #16) have been fully considered.

### ***Claim Objections***

2. Claims 3 and 16 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 3 and 16 seems to simply restate the recitations already claimed in Claim 1.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 and 3-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steinberg et al. (Steinberg) in view of Stephenson and Nishitani.

Steinberg discloses in Figure 1 and column 1, line 58 through column 4, line 62, a portable camera (ref. 10) for capturing a digital image and an integral programming language interpreter

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means for manipulation of the digital image and a script input means (ref. 18) for inputting a programming script on a card (ref. 22) wherein the script is executed to modify the image.

However, Steinberg does not disclose a digital camera with an integral printer and a card with a script and visual example of a likely effect of the script. Stephenson discloses in Figure 3, a digital camera with an integral printer. Nishitani discloses IC card (ref. 12) with a likely effect (ref. 14).

Although, Nishitani does not disclose an IC card with the script on one side and the visual example on the other, the location of the features on the card would have been an obvious design choice. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide an integral printer and a card with script and a visual example to the digital camera of Steinberg in view of Stephenson and Nishitani in order to instantly print the captured and modified digital image.

5. Claims 1 and 3-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steinberg et al. (Steinberg) in view of Finelli et al. (Finelli) and Nishitani.

Steinberg discloses in Figure 1 and column 1, line 58 through column 4, line 62, a portable camera (ref. 10) for capturing a digital image and an integral programming language interpreter means for manipulation of the digital image and a script input means (ref. 18) for inputting a programming script on a card (ref. 22) wherein the script is executed to modify the image.

However, Steinberg does not disclose a digital camera with an integral printer and a card with a script and visual example of a likely effect of the script. Finelli discloses a digital camera with a detachable printer which is made integral to the camera. Nishitani discloses IC card (ref. 12) with

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a likely effect (ref. 14). Although, Nishitani does not disclose an IC card with the script on one side and the visual example on the other, the location of the features on the card would have been an obvious design choice. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide an integral printer and a card with script and a visual example to the digital camera of Steinberg in view of Finelli and Nishitani in order to instantly print the captured and modified digital image.

*Remarks*

6. Applicant argues that Steinberg does not disclose the presentation of a visual example of the effect of the script. Although Nishitani discloses the use of cards to modify the operation of the camera, Nishitani does disclose a card that uses the script and provides a visual example of the effect of the script. Nishitani reference is used as a secondary reference to the Steinberg reference to show a card with a script and a visual example.

*Conclusion*

7. All claims are rejected.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

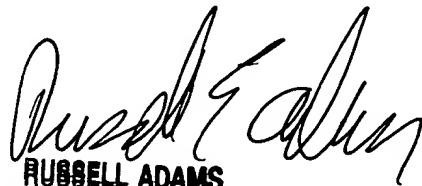
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Kim whose telephone number is (703) 305-0105. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 4:00 PM. The examiner can also be reached on alternate Fridays during the same hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russ Adams, can be reached on (703) 308-2847. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

PB/11

PBK

07/24/01

  
RUSSELL ADAMS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800